

## REMARKS

This Amendment is submitted simultaneously with the filing of a Request for Continuing Examination.

It is noted that claims 14-25 are rejected under 35 USC 102(b) over the U.S. patent to Richardson.

Claims 14-17, 20, 21, 23 and 25 are rejected under 35 USC 102(b) over the U.S. patent to Kronert.

Claims 14-25 are also rejected under 35 USC 102(b) over the U.S. patent to Nagy.

Claims 14-25 also are rejected under 35 USC 102(b) over the U.S. patent to Paul.

Claims 14-25 are further rejected under 35 USC 102(b) over the U.S. patent to Levedahl.

Also, the drawings in the claims are objected to and the claims are rejected under 35 USC 112.

In connection with the Examiner's objection to the drawings, applicant submitted herewith a copy of the drawings with changes provided in compliance with the Examiner's objections. Figure 1 was amended to show the complete cross section of the spur gear and the detent disk. Figures 2 and 3 now make clear that the detent disk has a substantial uniform material wall thickness, even while it has detent cams located on its annular surface. Figure 3 now also shows the root circle which is indicated by reference numeral 25. New Figure 4 shows that recesses can be used instead of detent cams on the annular surface of the detent disk.

It is believed that the Examiner's grounds for formal objections to the drawings should be considered as no longer tenable and should be withdrawn.

In view of the Examiner's formal rejection of the claims under 35 USC 112, applicants amended the claims to clarify the issues raised by the Examiner. As for the Examiner's statement that it was unclear how the thickness of the disk would remain uniform when its front surface includes portions with cams and/or recesses, it is respectfully submitted that the corresponding claims define a substantially uniform wall thickness, which is an accurate statement, while the cams and/or

recesses are additional formations independent from otherwise substantially uniform wall thickness.

Turning now to the Examiner's rejection of the claims over the art, applicants have carefully considered the grounds for the rejection applied by the Examiner against the original claims. In connection with this, Claim 14 has been amended by incorporating into it the features of Claim 18, and Claim 20 has been amended by incorporating into it the features of Claim 22.

It is respectfully submitted that Claims 14 and 20, defining a detent disk and an overload coupling, as well as Claim 25 which defines a machine tool including the overload coupling, clearly and patentably distinguish the present invention from the prior art applied by the Examiner.

The above mentioned independent claims define that in the detent disk of the overload coupling, the detent disk body is configured as a powder-metallurgy produced disk body and has a substantially uniform material wall thickness while also having detent cams and/or recesses on its annular surface.

The references applied by the Examiner, namely the U.S. patents to Richardson, Kronert, Nagy, Paul, and Levedahl do not disclose a detent disk body configured as a powder-metallurgy produced disk body and do not disclose a detent disk which has a substantially uniform material wall thickness. For example, it is clear from consideration of Figure 5 of the U.S. patent to Richardson, that the detent disk body disclosed in this reference has alternating ridges and notches and does not have a uniform material wall thickness.

It is therefore believed to be clear that the new features of the detent disk and the overload coupling in accordance with the present invention are not disclosed in the references.

The Examiner rejected the claims over the above described references as being anticipated. In connection with this it is believed to be advisable to cite the decision *In Re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”

Definitely, the references do not disclose each and every element present invention as now defined in Claims 14, 20 and 25.

It is therefore respectfully submitted that the anticipation rejection applied by the Examiner against the original claims should be considered as not tenable with respect to Claims 14, 20 and 25 and should be withdrawn.

Also, the references do not contain any hint or suggestion for the above mentioned new features of the present invention, and they do not disclose any motivation for providing such features. Therefore, a person skilled in the art would not arrive at the present invention as defined in Claims 14, 20 and 25 as a matter of obviousness. In order to arrive at the applicant's invention from the teachings of the references, the references have to be fundamentally modified, and in particular by including into them the new features of the present invention as now defined in amended Claims 14, 20 and 25.

However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision In Re Randol and Redford (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

In view of the above presented remarks and amendments, it is believed that Claims 14, 20 and 25 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on the corresponding independent claims, they share their allowable features, and they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue.

Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael J. Striker', with a long horizontal flourish extending to the right.

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